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| APPLICATION NO.                                         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|---------------------------------------------------------|-------------|----------------------|------------------------------|------------------|
| 10/682,586                                              | 10/09/2003  | Edward R. diGirolamo | 4782-030                     | 9767             |
| 24112                                                   | 7590        | 05/30/2006           |                              |                  |
| COATS & BENNETT, PLLC<br>P O BOX 5<br>RALEIGH, NC 27602 |             |                      |                              |                  |
|                                                         |             |                      | EXAMINER<br>A, PHI DIEU TRAN |                  |
|                                                         |             |                      | ART UNIT<br>3637             | PAPER NUMBER     |

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/682,586

Applicant(s)

DIGIROLAMO ET AL.

Examiner

Phi D. A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 9,10,12-20 and 25-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,11,21-24,34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Election/Restrictions***

1. Claims 9-10, 12-20, 25-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention of groups II and III, and species of figures 2-5, 8, 10, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/6/06.
2. Applicant's election of claims 1-8, 11, 21-24, 34-38 in the reply filed on 3/6/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“ may be connected” is indefinite as it confuses the scope of the claim. The claim is thus indefinite.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-3, 11, 21-24, 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Vukmanic (4677802).

Vukmanic shows a stud spacer (12) for extending between two studs with each stud having an opening therein, the spacer comprising a main member (17), the main member including first and second end portions(40), a projection (41) extending from one of the end portions, an opening (50) formed in the other end portion and wherein one stud spacer may be connected to another stud spacer by extending the projection of the one stud spacer through the opening within one stud and into the opening of another stud spacer, at least one flange (71) for connecting to one of the two studs, spaced apart flanges (71, and at 40) for connecting to one of the two studs, the opening formed in the second end portion of the main member including a slot, a projection receiver (50) formed in the other end portion, either the projection or projection receiver including one or more locking members such that when a projection of one of the spacer is projected into the receiver of another spacer, a locked condition is realized, either the projection or projection receiver includes one or more stops for engaging the one or more locking members (figure 4), the locking members are disposed on the projection and the stops form a part of the receiver, at least a portion of the projection is deflectable in response to the projection engaging the receiver, the projection and receiver are disposed such that when consecutive stud spacers are connected together, the projections and receivers will overlies each other (figure 4), the projection and receiver include a flap that is at least partially flexible, in a locked position, the flaps of the projection and receiver engage each other (figure 4), both the projection and receiver include a flexible flap, a hold down element, an opening disposed

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between the flap and the hold down element, a deflector, an opening disposed between the deflector and the hold down element.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kovar et al (4246736).

Kovar et al shows a stud spacer (10), the spacer comprising a main member, the main member including first and second end portions (13, 14), a projection (19, 71) extending from one of the end portions, an opening (between 15 and 16) formed in the other end portion and wherein one stud spacer may be connected to another stud spacer by extending the projection of the one stud spacer through the opening within one stud and into the opening of another stud spacer, at least one flange (the part to the left of part 74, 73, figure 8) for connecting to one of the two studs, spaced apart flanges (the parts to the left of part 74, 73, figure 8) for connecting to one of the two studs, the main member including a pair of side flanges (12, 25, figure 1) and a pair of end flanges (the part to the left of part 74, 73, figure 8), the end flanges are adapted to be connected to the two studs that the stud spacer extends between, the main member includes a central section (figure 2A, the portion in the middle), and wherein the side flanges (25) are turned out of the plane of the central section, the end flanges and the side flanges are turned in opposite directions with respect to the central section (the orientation of the side flanges in figure 1 and the orientation of the end flanges in figure 8), at least one end flange is divided into at least two portions (figure 8) and the projection (71) extends between the two portions.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

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is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-8, 11, 21-24, 34-38 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-13 of copending

Application No. 10/910114. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the claims are to the same structure although using different terminology.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

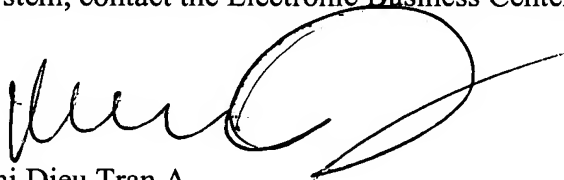
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different spacing device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

Phi Dieu Tran A

5/25/06